

REMARKS

Presently, claims 18-34 are pending in the application.

Claim Rejections – § 103(a)

The Examiner has rejected claims 18-19, 21, 27, 29, 31, 32 and 34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,652,615 to Bryant *et al.* (“Bryant”) in view of U.S. Patent Application No. 2002/0055880 to Unold *et al.* (“Unold”). The Examiner contends that Bryant teaches all features of the claimed invention with the exception of generating one or more groups of subavails where at least one of the groups has a total expected viewership greater than or equal to the expected viewership of one of the advertising opportunities. The Examiner further contends that Unold teaches these features, and concludes that it would have been obvious to modify Bryant’s system to include generating the groups of subavails where at least one has a total expected viewership greater than or equal to that of one of the advertising opportunities as taught by Unold, resulting in Applicants’ claimed invention. Applicants respectfully traverse this rejection.

Bryant teaches a system for inserting fill segments into a broadcast program at the time of program distribution. In Bryant, the selection of fill segments is performed by the system at the time of program distribution. That is, Bryant’s system makes the selection of fill segments while transporting the program to the customer. Furthermore, Bryant is silent with respect to the selection of specific fill segments by advertisers.

Unold teaches a system of creating and managing electronic advertisements for digital signs. In Unold, one or more commonly-owned digital signs are grouped together as a single site, and groups of advertising spots associated with a particular site are reserved by advertisers prior to program distribution. Unold teaches the entry by the operator of site information which may be of interest to an advertiser, including the daily number of viewers of the entire site. Unold is silent, however, with respect to the expected viewership of any particular advertising spot.

Applicants’ claimed invention includes creating subavails, which are sections of advertising opportunities. Each subavail has an expected viewership, and groups of

subavails are generated such that at least one of the subavail groups has an expected viewership greater than or equal to that of one of the advertising opportunities from which the subavail group originated.

Independent claim 18 recites:

A method of managing advertisement opportunities or avails in a television network environment, the method comprising:

(a) recognizing one or more advertisement opportunities, each advertisement opportunity having an expected viewership;

(b) creating a plurality of subavails based on the recognized advertisement opportunities, wherein each subavail is directed at a target audience group and each subavail is associated with a portion of the expected viewership of its corresponding advertisement opportunity; and

(c) generating one or more groups of subavails by aggregating the plurality of subavails from at least two of the advertisement opportunities, wherein at least one of the groups of subavails has a total expected viewership greater than or equal to the expected viewership of one of the advertisement opportunities from which the subavails in the at least one group originated.

When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a prima facie case of obviousness. The Examiner can satisfy this burden only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. Ex Parte Dussaud, 7 U.S.P.Q.2d 1818, 1820 (Bd.Pat.App & Interf. 1988).

Initially, Applicants respectfully point out that the Examiner has not pointed to a teaching in either Bryant or Unold that suggests the desirability of combining such

references. Rather, the Examiner has made a general allegation “that it would have been obvious to one of ordinary skilled in the art to modify” Bryant with Unold (see page 4 of the Office Action). For this reason alone, the Examiner has not established a prima facie case of obviousness.

Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01.

The proposed modification of Bryant to include the selection by advertisers of grouped advertising slots before program distribution (as taught by Unold) would change the principle of operation of Bryant’s system. That is, in Bryant, since the system selects the desired fill segment at the time of program distribution, Bryant does thus not teach or suggest selecting fill segments before program distribution. Thus, incorporating Unold’s distribution system of pre-selected advertisements into Bryant would not allow Bryant’s system to operate under the principle that fill segments are selected by the system at the time of program distribution.

Additionally, the prior art references, when combined, must teach or suggest all of the claim limitations. See MPEP 2143.03.

Applicants respectfully submit that Bryant does not teach or suggest subavails that have expected viewership associated therewith. Moreover, Bryant does not teach or suggest the concept of accounting for the number of viewers generally. Thus, as the Examiner admits, Bryant certainly does not teach or suggest groups of subavails where at least one of the groups has a total expected viewership greater than or equal to the expected viewership of one of the advertising opportunities. The concept of the expected viewership of a group of subavails is also not taught by Unold. Although Unold teaches a much coarser site-based measure of viewership (e.g., the daily number of viewers of a particular site), expected viewership of a group of subavails cannot be determined therefrom. Therefore, the proposed combination of Bryant and Unold is lacking at least this feature, and as such, does not disclose all of the features of independent claim 18.

Applicants respectfully submit that the Examiner has not met the burden of prima facie obviousness, since the Examiner has not pointed to an objective teaching or combination of references which disclose Applicants' claimed invention and the motivation to combine them, combining the references would require a fundamental change in operation of the primary reference, and even assuming the references were properly combinable, not all of the limitations would be taught. Accordingly, independent claim 18 is believed to be allowable over the combination of Bryant and Unold.

Independent claim 29 recites a system that includes "a subavail generation module ... to create ... subavails ... wherein each subavail is directed at a target audience ... and a grouping module ... to create ... groups of subavails ... wherein at least one of the groups ... has a total expected viewership greater than or equal to the expected viewership of one of the advertisement opportunities ...".

For the same reasons discussed above with respect to independent claim 18, the combination of references neither discloses Applicants' claimed invention nor the motivation to combine them, combining the references would require a fundamental change in operation of the primary reference, and even assuming the references were properly combinable, not all of the limitations would be taught. Accordingly, independent claim 29 is believed to be allowable over Bryant and Unold, both individually and in combination.

Dependent claims 19, 21, 27 and 31, 32 and 34 are allowable at least by their dependency on independent claims 18 and 29, respectively.

Reconsideration and withdrawal of the Examiner's §103(a) rejection of claims 18-19, 21, 27, 29, 31, 32 and 34 are respectfully requested.

The Examiner has rejected claims 20, 22-26, 28, 30 and 33 under 35 U.S.C. §103(a) as being unpatentable over Bryant in view of Unold and further in view of International Patent Application Publication No. WO 00/33163 to Eldering ("Eldering"). Applicants respectfully traverse this rejection.

As discussed above with respect to the Examiner's obviousness rejection of claims 18-19, 21, 27, 29, 31, 32 and 34, independent claims 18 and 29 are believed to be

allowable over the combination of Bryant and Unold. Applicants respectfully submit that Eldering does not teach or suggest any of the elements missing from such combination. Thus, independent claims 18 and 29 are believed to be allowable over the combination of Bryant, Unold and Eldering. Accordingly, claims 20, 22-26, 28 and 30, 33 are allowable at least by their dependency on independent claims 18 and 29, respectively.

Furthermore, the Examiner has taken Official Notice (see page 11 of the Office Action) that it is “notoriously well known to have advertisements that are gathered from the same channel so as to increase the chance of the profiled subscriber receiving the targeted advertisement over time.” However, Applicants disagree that there are “facts beyond the record” which are “capable of such instant and unquestionable demonstration as to defy dispute” as being ‘well-known’ in the art, as required by M.P.E.P. §2144.03, which would support an Examiner’s finding of Official Notice.

Applicants respectfully traverse the Examiner’s taking of Official Notice, and respectfully request that the Examiner support the taking of Official Notice by producing a relevant reference that shows/teaches “advertisements that are gathered from the same channel so as to increase the chance of the profiled subscriber receiving the targeted advertisement over time”, and that the Examiner identify a specific teaching in the reference to support a combination with Bryant, Unold and Eldering.

Reconsideration and withdrawal of the Examiner's §103(a) rejection of claims 20, 22-26, 28, 30 and 33 are respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 18-34, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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